

Remarks/Arguments:

Applicants wish to thank Primary Examiner Mark L. Berch for the courteous consideration rendered Applicants' representative during an interview at the PTO on June 7, 2004 ("the interview"). The substance of the interview statement was filed July 12, 2004, in the PTO.

Claims 20-24, previously presented, are pending. Claim 20 is amended hereby.

Entry of the instant amendment after final rejection is appropriate, since it would place the subject application in form for immediate allowance. As explained below, the amendment resolves the only remaining issue of record – the rejection of claims 20, 21, and 24 under §112, ¶1 – and, otherwise, merely corrects inadvertent errors and omissions in claim 20, as originally presented.

First of all, claim 20 is hereby amended pursuant to the interview with the Examiner. The corresponding official Interview Summary (dated 04 June 2004) records the Examiner's suggestions for amendments to the claims. Applicants understanding is that amending the claims, hereby, in accordance with the Examiner's suggestions, resolves the only remaining issue of record, i.e., it overcomes the rejection of claims 20, 21, and 24 under §112, ¶1. Applicants wish to thank the Examiner for kindly suggesting the constructive claim amendments.

Claim 20 is further amended, hereby, to correct inadvertent clerical errors and omissions appearing in the claim as originally submitted. The "carboxyl group" and "thiocarboxyl group" mistakenly recited as alternatives for variables "X and Y" are deleted from the claim. The first of two occurrences of "carboxyl" in the Markush group from which the "substituents on X and Y are selected" – the occurrence at the 7th line from the end of claim 20 – is canceled (the second

occurrence is at the 3rd line from the end of the claim). The definition of the carboxyl ester "CO₂R₃" in claim 20 is revised to include inadvertently omitted features (1) "lower alkynyl carboxyl esters" (specification page 14, line 26) among the recited Markush-group alternatives and (2) that the recited alternatives "may be substituted" (specification page 14, lines 35-36) (the cited, supporting passages of the specification are highlighted on the copy of page 14 attached, hereto, for the Examiner's convenience).

Claims 22 and 23 were found to contain allowable subject matter (final Office Action, page 3). Applicants wish to thank the Examiner for the timely notice of allowable claims.

Claims 20, 21, and 24 were rejected under 35 USC 112, first paragraph, for allegedly lacking descriptive support in the application as originally filed, i.e., a "new matter" rejection. Reconsideration of the rejection is requested in view of the amendments to the claims, above, taken in conjunction with the remarks that follow.

According to the statement of rejection, the "carboxyl group" and "thiocarboxyl group" recited as alternatives for variables "X and Y" constitute new matter. In that the instant amendment deletes "carboxyl group" and "thiocarboxyl group" as alternatives for variables "X and Y," this reason for the rejection is rendered moot.

Further according to the statement of rejection, the Markush group from which the "substitutents on X and Y are selected" include alternatives that allegedly lack descriptive support in the application as originally filed. Allegedly, the alternatives "carboxyl" and "alkyloxycarbonyl, alkenyloxycarbonyl, aralkyloxycarbonyl, aryloxycarbonyl, alkylthiocarbonyl, alkenylthiocarbonyl,

aralkylthiocarbonyl, arylthiocarbonyl" constitute new matter. As explained during the interview, the aforesaid alternatives for "substituents on X and Y" not constitute new matter.

With respect to "carboxyl" as one of the "substituents on X and Y," attention is directed to page 15, lines 16-20, and page 16, lines 10-15, i.e., (*emphasis added*):

Preferred examples of the groups represented by X and Y include . . . the below-described groups:

Referring to the alkyl, alkenyl, aralkyl, aryl, alkylthio, alkenylthio, aralkylthio, arylthio, alkyloxy, alkenyloxy, aralkyloxy and aryloxy groups, namely, as the alkyl group, there are mentioned linear or branched lower alkyl groups . . .

These alkyl, alkenyl, aralkyl, aryl, alkylthio, alkenylthio, aralkylthio, arylthio, alkyloxy, alkenyloxy, aralkyloxy, aryloxy and silyloxy groups may be substituted in their individual groups with one or more substituents, for example . . . *carboxyl group*.

Accordingly, and contrary to the new-matter allegations, the "carboxyl" recited as an alternative substituent on "X and Y" (3rd line from the end of the claim), as currently amended, is supported by the application as originally filed. The "carboxyl" appearing at the 7th line from the end of claim 20, which is also mentioned in the statement of rejection, is redundant and, so, canceled from the claims, hereby, as explained above.

Attention is, further, directed to the Decision on Appeal, mailed August 30, 2002, in connection with descriptive support for "carboxyl" as one of the "substituents on X and Y." The Board found (page 7, third paragraph) (emphasis in original):

The specification states that possible substituents for alkyl (including alkylthio and alkyloxy) groups include carboxyl, ester, and thioester groups. Page 17, lines 6-15. The same applies to possible substituents for alkenyl, alkenylthio, alkenyloxy, aralkyl, aralkylthio, aralkyloxy, aryl, arylthio, aryloxy, amino, carbamoyl, carbamoyloxy, imino-lower alkyl, imino-lower alkylamino, and amid moieties. See

page 17, line 16, to page 18, line 17. However, none of the possible substituents includes the thiocarboxyl group recited in the claim 15.

Accordingly, the Board neither made, nor affirmed, any finding that the appearance of "carboxyl" in the claims as one of the "substituents on X and Y" constitutes new matter. Quite the contrary, the Board found that the written description requirement of section 112, paragraph one, is satisfied for reciting "carboxyl" as one of the "substituents" on X and Y, as set forth in the passage from the Board's decision, quoted above.

For the foregoing reasons, the rejection of claims 20, 21 and 24 under 35 USC 112, first paragraph, based on reciting "carboxyl" alternatives for the "substituents on X and Y" cannot be maintained. Withdrawal of the rejection, on this basis, appears in order.

With respect to "the ester and thioester groups appearing in the last three lines of claim 20" allegedly constituting new matter, attention is directed to pages 16-23 of the subject application, which read in pertinent part (*emphasis added*):

These [X and Y alternatives] alkyl, alkenyl, aralkyl, aryl, alkylthio, alkenylthio, aralkylthio, arylthio, alkyloxy, alkenyloxy, aralkyloxy, aryloxy and silyloxy groups may be substituted in their individual groups with one or more substituents, for example . . . the below-described heterocyclic, heterocyclic-thio, heterocyclic-oxy, acyl, ester, thioester and amide groups. . . .

As the acyl group, there may be mentioned *alkylcarbonyl, alkenylcarbonyl, aralkylcarbonyl, arylcarbonyl, alkylthiocarbonyl, alkenylthiocarbonyl, aralkylthiocarbonyl, arylthiocarbonyl, alkyloxycarbonyl, alkenyloxycarbonyl, aralkyloxycarbonyl, aryloxycarbonyl*.

As apparent from the specification text quoted above, and contrary to the statement of rejection, the substituents recited in the last three lines of claim 20 are *not* "broader than appears in the

specification" (final Office Action, page 2) and, in fact, find express, descriptive support in the subject application as originally filed.

For the foregoing reasons, the rejection under section 112, first paragraph, based on alleged lack of descriptive support for the substituents recited in the last three lines of claim 20 cannot be maintained. Withdrawal of the rejection, on this basis, appears in order.

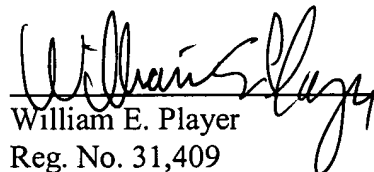
Accordingly, claims 22 and 23 being found allowable (as explained above), and claims 20, 21, and 24, as amended hereby, being allowable for the aforesaid reasons, all issues of record are resolved, hereby, and the subject application is in form for immediate allowance.

Favorable action is requested.

Respectfully submitted,

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